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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,872	06/26/2003	Richard Hunter Harris	RPS920020124US1	7859
45219	7590	11/02/2005	EXAMINER	
KUNZLER & ASSOCIATES 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HA

Office Action Summary	Application No.	Applicant(s)	
	10/608,872	HARRIS ET AL.	
	Examiner	Art Unit	
	Daniel I. Walsh	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-19 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-19 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 19 August 2005 and IDS of 24 November 2004.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 16, 24, and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of copending Application No. 2004/0223663 in view of US 6,167,381.

For example:

Claim 1 of the present application claims:

i) "...identifying an item...processor...memory...reader...capture module...association module...verify the identify of the item based on the visual characteristic...audio information..." (see claim 1).

Claim 16 of the present application claims:

ii) "...reading a coded identifier...capturing a visual characteristic...verify the identity of the item based on the visual characteristic..." (see claim 16).

Claim 24 of the present application claims:

iii) "...reading a coded identifier...capturing a visual characteristic...identifying the item...verifying the identity of the item based on the visual characteristic..." (see claim 24).

Claim 27 of the present application claims:

iv) "...reading a coded identifier...capturing a visual characteristic...identifying the item...verifying the identity..." (see claim 27).

Whereas in the '663 Patent Application, the Applicant claims:

i) "...reading said machine readable information....determining a dimensions of a first visible feature...comparing said dimension of said first visible feature of said item being scanned with said dimension of said first visible feature of said item corresponding to said value represented by said machine readable information." (see claim 1).

The '663 Patent application appears to teach scanning a barcode to identify an item, retrieving visual data, and verifying the item by use of the visible data. Though the '663 Patent

Application does may not include the identical recitation of modules, the Examiner notes that it would have been obvious to one of ordinary skill in the art to use modules as part of the machine process in order to complete the item identification.

Though the '663 Patent Application is silent to providing audio data regarding items, the Examiner notes that the '381 Patent teaches such limitations (col 4, lines 5+).

It would have been obvious to one of ordinary skill in the art to combine the teachings of the '663 Patent application with those of the '381 Patent in order to provide more item information.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 3 recites a confirmation module that confirms with a user the identity of the item "based on the coded identifier" (line 3). However, the specification does not describe the confirmation module confirming the item identity this way. The specification describes that the identity of the time is confirmed based on a visual characteristic (page 14, for example), when there are multiple

candidate items. Additionally, it is unclear why confirmation would be necessary based on a coded identifier, as coded identifiers would not produce multiple candidates like visual characteristics would.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 8, 9, 16, 21, 23, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iizaka et al. (US 5,609,223) in view of Swaine et al. (US 6,167,381).

Re claim 1, Iizaka et al. teaches an apparatus for positively identifying an item comprising a processor configured to execute data structures and a memory connected to the processor for storing the data structures (CPU 202 and FIG. 3). Iizaka et al. teaches barcode scanner 31 to read a coded identifier associated with the item, and video camera 30 to capture a

visual characteristic of the item independent of the coded identifier. Iizaka et al. teaches identifying the time in a database based on the coded identifier (col 9, lines 5+). Iizaka et al. teaches verifying the identity of the item based on the visual characteristic (col 9, lines 10+). Though Iizaka et al. is silent to the data structures comprising modules, the Examiner notes that as the POS device has the corresponding structure and processing means as claimed, it would have been obvious for them to be modules of the data structures, in order to the POS to perform the identification/verification/association process.

Re claims 8 and 23, Iizaka et al. teaches that the visual characteristic is selected from color, shape, size, and texture (col 4, lines 30+).

Re claim 9, though silent to a confirmation module to confirm the identity of the item, Iizaka et al. teaches the item is confirmed (col 9, lines 10+). As such a process is part of the scanning process, it would have been obvious to have a confirmation module, in order to have a memory stored program/steps in order to accurately complete the item identification.

Re claim 16, the limitations have been discussed above.

Re claim 21, The Examiner notes that it is well known and conventional in the art to identify items by a visual signature (produce, for example). As unique information is received (discussed above) from the visual capturing (size, shape, color), the Examiner broadly interprets that as a visual signature, as it is well known to identify items by a signature, with accuracy.

Re claim 24, the limitations have been discussed above. Re claim 27, the limitations have been discussed above.

Iizaka et al. is silent to a presentation module to provide audio information about the item.

The Examiner notes that providing item audible information is well known and conventional in the art to benefit those maybe visually impaired. Specifically, Swaine et al. teaches a presentation module presenting audio information about the item (col 4, lines 5+).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Iizaka et al. with those of Swaine et al.

One would have been motivated to do this to provide item information to the user for convenience, or to provide information to those users who are vision impaired, to facilitate the checkout/scanning process.

5. Claims 3, 4, 7, 10, 12, 17-18, 22, 25, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iizaka et al./Swaine et al., as discussed above, in view of Novak, as cited in the previous Office Action.

The teachings of Iizaka et al./Swaine et al. have been discussed above.

Re claim 3, Iizaka et al. is silent to confirming the item identified by the coded identifier.

Re claims 4 and 10, Iizaka et al. is silent to the presentation module presenting to the user a plurality of candidate items associated with the visual characteristic and enable the user to identify from the plurality of candidate items, the item. Re claim 7, Iizaka et al./Swaine et al. are silent to a weight module to confirm item identity based on the weight.

Re claim 3, Novak teaches confirmation of item identity to be made through use of barcodes (abstract). Accordingly, the Examiner notes it would have been obvious to one of ordinary skill in the art to combine the teachings of Novak with those of Iizaka et al./Swaine et al. in order to provide for means to confirm identity of items.

(Re claims 4 and 10, Novak teaches such limitations (col 4, lines 60+). Though silent to a presentation module, the Examiner notes that it would have been obvious to have such steps part of a presentation module in order to increase the accuracy of the item identification in certain instances where doubt may arise from strictly automated processes.

Re claims 7, 12, 22 Novak teaches a weight module (FIG. 4) which is used to identify and associate the weight of the item with a candidate/assist in identifying.

Re claims 17-18, the limitations have been discussed above. The Examiner notes that by presenting the candidate items to the user, the user is able to confirm an identity.

Re claim 25, it has been discussed above that a user can confirm/verify the identity of the item.

Re claim 29, the limitations have been discussed above re claim 4.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Iizaka et al./Swaine et al. with those of Novak.

One would have been motivated to do this to help confirm the item by its weight, to increase accuracy.

6. Claims 5, 11, 19, 26, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iizaka et al./Swaine et al., as discussed above, in view of Hertz et al, as cited in the previous Office Action.

The teachings of Iizaka et al./Swaine et al. have been discussed above.

Re claims 5, 11, 19, 26, 28, and 30 Iizaka et al./Swine et al. are silent to a notification module notifying a user whether the coded identifier is associated with the item.

Hertz et al. teaches such limitations (col 7, lines 1+) which teaches notifying the user when the coded identifier is correct/associated with an item. The Examiner notes it would have been obvious to one of ordinary skill in the art to have the notification module part of the data structures in order to perform a function automatically or part of a process, in order to have accuracy and consistency. Additionally, notifying a user of the pass/failure when identifying an item is an obvious expedient to help in the item identification and provide data/information to the user necessary to complete the transaction.

At the time the invention was made it would have been obvious to one of ordinary skill in the art to combine the teachings of Iizaka et al./Swaine et al. with those of Hertz et al.

One would have been motivated to do this in order to provide information to a user to confirm the item and ease the process.

7. Claims 13, 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iizaka et al./ Swaine et al., as discussed above, in view of Seevers et al., as cited in the previous Office Action

The teachings of Iizaka et al./Swaine et al. have been discussed above.

Iizaka et al./Swaine et al. are silent to a server associating and verifying the items.

Seevers et al. teaches a server 16 remote to the checkout station to communicate with a plurality of checkouts. The server executes recognition software to obtain data from the data collector via the computer and network, and identifies items by comparing produce data in produce data 42 with collected produce data and retrieves the corresponding item identification information to forward the information to the control circuitry for checkout (col 4, lines 25+).

Seevers et al. teaches a server that executes the item recognition software as opposed to it being done locally.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Iizaka et al./Swaine et al. with those of Seevers et al.

One would have been motivated to do this to have a server in communication with the checkout station to verify/identify items, since having a server to recognize items and send product information is well know and conventional in the art, and is desirable since it can be easily added to current point of sale devices without having to replace the entire system. In addition, by employing a remote server to perform the transactions/processing as opposed to each station requiring the hardware/software, costs are reduced.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Additional Remarks

9. The Examiner notes that of the independent claims (1, 9, 13, 16, 24, and 27) only claim 1 recites that the visual characteristic is capture independent of the coded identifier, as the other claims recite that the visual characteristic is captured independent of the reading of the coded identifier. Accordingly, the Examiner notes that the prior art of Hertz et al. (as cited in the previous Office Action) still reads upon the limitations set forth by the independent claims excluding claim 1, as the Examiner notes that capturing of the image information and actual

reading are independent and separate. Accordingly, the Examiner suggests that the claim language regarding the independence be consistent between the independent claims, to expedite prosecution.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

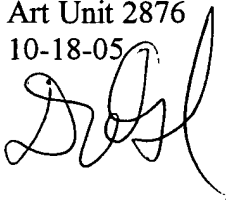
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
10-18-05



KARL D. FRECH
PRIMARY EXAMINER